

Upon the request by Applicant's attorney, an interview with the Examiner took place on February 14, 2006. At the interview, Applicant's attorney questioned the propriety of the final action and the Examiner answered that the final action was proper because new grounds of rejection was necessitated by Applicant's last amendment. When Applicant's attorney pointed out that the element 48 in the Trebitz reference cited by the Examiner as a clip is indeed a handguard according to the disclosure of the Trebitz reference, the Examiner replied that it acts as a clip because it meets the structural limitations of the claims. The Examiner also said that the Trebitz reference teaches that the handle and clip may be integrally formed in one unit as required by the claims. Finally, when Applicant's attorney indicated an intent to file an amendment with remarks as well as a Notice of Appeal, the Examiner agreed to consider them to see if there is any allowable subject matter.

II. Applicant's Response

A. Nature of Current Amendment

Pursuant to the interview with the Examiner, Applicant presents amended claims and arguments rebutting the rejections in the final office action. Applicant has previously filed a Notice of Appeal.

Applicant understands that an amendment after final action may not be entered as a matter of right. However, a post-final-action amendment can be entered if it presents rejected claims in better form for appeal in compliance with 37 CFR 1.116(b). MPEP 714.12. Applicant believes such is the case with the current amendment because it merely cancels a few claims and rephrases the original claim language in order to provide more clarity to what is claimed and thus, place the claims in better condition for appeal. The current amendment does not add any

new claim, introduce any new element or new limitation, or raise any new issue requiring further consideration or search as will be shown below. Applicant believes it would require only a cursory review by the Examiner and therefore, should be entered. Also, since the current amendment is not believed to touch the merits of the application, it would not be subject to the requirement of a showing under 37 CFR 1.116(c).

B. Amended Independent Claim 6, Original Dependent Claim 7, and Amended Dependent Claim 8 Are Not Anticipated by the Trebitz Reference.

As understood by Applicant, the Trebitz reference discloses a beverage vessel with a ring structure around the upper rim of the vessel body, a handle, and a heat-insulating handguard covering the outside wall of the vessel to protect a hand holding the vessel from the possibly hot vessel. Anticipation requires that each and every element of the claimed invention be disclosed in a single relevant prior art reference. *Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ 1241, 1245 (Fe. Cir. 1987). Applicant respectfully submits that the Trebitz reference cannot anticipate Claim 6 because firstly, the handguard disclosed in the Trebitz reference cannot be the clip in Claim 6 in its structure, function, and purpose, and secondly, even assuming *arguendo* it were, it is not solely connected to the handle of the vessel as required in Claim 6.

Amended Claim 6 discloses a unitary construction comprising a clip and a container handle, and sets out four structural limitations. The Examiner pointed out that the Trebitz reference disclosed two of the four limitations, that is, the clip being configured and situated such that in unstressed condition it is biased toward the container body, and the clip being integrally formed with the handle. Even admitting the Examiner's view, Applicant submits that still, the Trebitz reference fails to disclose the other two structural limitations of Claim 6 as follows.

First, the Trebitz reference fails to teach the limitation of Claim 6 that the clipping portion is capable of being further separable from the container body resiliently. This limitation relates the inherent characteristic of a clip. The resilience of the clip may come from either the material composing the clip or some spring means. This limitation is essential in order for the clip in Claim 6 to properly function as a clip because otherwise, it would not be able to releaseably retain an article of a suitable size against the container. This limitation is further needed to achieve one of the objectives of the clip disclosed in the specification, that is, having the capability of holding articles of varying thickness. (Application at page 4, lines 19-21). Although the claim language describing this feature has been added by the current amendment, Applicant maintains that it constitutes neither new matter nor a new limitation because once the original language of the claims has introduced an element and named it as ‘a clip’, then necessarily, this inherent feature of a clip must follow whether expressly stated or not in the original claim.

The handguard 48 in the Trebitz reference fails to disclose this limitation. There is nothing in the Trebitz reference that indicates, explicitly or implicitly, that the handguard 48 is ‘ever separable’ from the vessel body. Rather, the Trebitz reference indicates that the handguard 48 is structured to “extend[s] slightly inwardly in downward direction” as shown in FIG. 2 such that when fitted onto a vessel, it becomes “equally biased into engagement with the outside of the [vessel body].” (See Col. 4, lines 34-38). According to Applicant’s understanding, this cited language seems to support the notion that the handguard 48 in the Trebitz reference is intended to remain tightly engaged with, rather than separable from, the vessel body. Further support may be found when considering the function and purpose of the handguard 48 disclosed in the Trebitz reference which, as the Examiner agreed, serves to protect a cup-holding hand from the potential

heat of a cup. (*See* Col. 3, lines 8-13). This purpose and function is incongruous to those for a clip and therefore, making the handguard 48 easily separable from the vessel body would do no conceivable good in furthering its purpose or usage. And most importantly, there has been no such disclosure, whether explicitly or implicitly, in the Trebitz reference.

Another limitation of amended Claim 6 the Trebitz reference fails to disclose is that the clip is solely connected to the handle. This limitation is distinct and separate from the limitation that the clip is integrally formed with the handle. From the original claims through the last and currently amended claims, two different languages, “integrally formed” and “connected to or with”, have been consistently and purposefully used to represent distinct and separate limitations in defining the structure of the present invention. The language “integrally formed” has been employed to define a manufacturing mode requiring that several elements constituting the present invention be manufactured overall as a ‘single piece’ by, for example, such a method as ‘molding.’ But that language does not define the inner structure of the single piece, i.e., how the parts constituting the ‘single piece’ are connected, related with, or positioned with respect to, one another.¹ Merely saying “all parts are integrally formed” is not enough to adequately describe an invention and additional limitation further defining the inter-connections of parts is needed. That is precisely what the limitation “connected to or with” attempts to do in Claim 6 and other claims. According to this structural limitation in Claim 6, the clip must be solely connected to the handle, meaning that it cannot be connected to any other element in the unitary construction when more elements are added and integrally formed with the unitary construction, and not

¹. For example, a device may be manufactured as a ‘single piece’ such that all its parts A, B, C are integrally formed with one another. But this does not necessarily mean that every part is connected with every other part. It is possible that A is connected with B, B is connected with C, but A and C are not connected with each other while all three still remain integrally formed. Other mode of connection is also possible, and then, it would define a different structure.

connected to any other part of the drinking container when the unitary construction is attached to the container. FIGS. 1-5 describing the preferred embodiment of the present invention also clearly demonstrates this limitation. The clip is clearly depicted as connected to only the handle, not the rim, the cup liner, or any other part of the drinking container assembly, although the location of it need not be restricted to underneath of the handle as depicted in the figures. Here, Applicant also points out that the word 'solely' added in the current amendment before the word 'connected' does not constitute a new limitation, but merely clarifies what the pre-amended claim language already meant.²

The handguard in the Trebitz reference fails to meet this limitation as well, even assuming *arguendo* it is a clip, which it is not because it fails to meet another limitation as discussed before. The specification of the Trebitz reference states that "[t]his handguard too may be integrally formed with the ring." (Col. 3:12-13). If the handguard is integrally formed with the ring, or the rim in the term of Claim 6, it is necessarily connected with the ring. FIGS. 1 and 2 of the Trebitz reference also clearly show that the handguard 48 is connected not only with the handle 46, but also with the ring structure 28. In fact, the upper section of the handguard 48 becomes itself a part of the ring structure, i.e, the outer dent means 38 and the leg wall 32. Since

². The pre-amended Claim 6 stated that "a clip [is] connected to, integrally formed with, a drinking container handle." The language "connected to" should be construed to mean "solely connected to." If the language "connected to" were used to mean simply, "the clip is connected to the handle", that language would be redundant or without a purpose because just saying 'the clip is integrally formed with the handle' would have been enough to convey such a meaning where there are only two elements, the handle and clip. Similar logic applies to, for instance, dependent Claim 8 where an additional element, a rim, is incorporated into the unitary construction of Claim 6. After stating that a rim is integrally formed into the unitary construction, the pre-amended language of Claim 8 further states that 'a rim is connected to the handle'. If this language were not meant to restrict the connection of the rim solely to the handle, it did not have to be present in the claim at all in the first place. If the claim intended to allow the rim connected to both the handle and clip, then just saying 'the rim is integrally formed into the unitary construction' would have been enough because by saying that, the possibility for both connections would have been already implied. There was no need to make a further reference to a connection, singling out the handle. For this reason, Applicant submits that the language of 'sole connection' in amended claims is nothing but the logical consequence of the pre-amended language in Claims 6 and 8, and thus, not a new limitation.

the handguard 48 is not so structured or configured as to be solely connected to the handle, the Trebitz reference fails to teach the forth structural limitation.

As stated before, anticipation requires that each and every element of the claimed invention be disclosed in a single relevant prior art reference. *Id.* at 1245. Since the Trebitz reference fails to teach the two structural limitations of Claim 6, i.e., the further, resilient separability of the clip from the container body and the sole connectivity of the clip to the handle, it cannot anticipate Claim 6. Also, in the respect that the parent Claim 6 is distinguishable from the Tebitz reference, its dependent Claims 7 and 8 should be deemed distinguishable as well. Particularly, the amended Claim 8 expressly requires that the rim, the newly added element in Claim 8, be solely connected to the handle, which is perfectly consistent with the fourth limitation of Claim 6. As shown above, the ring structure in the Trebitz reference is connected not solely to the handle, but to the handguard as well, and therefore fails to meet this limitation.

C. Amended Claims 6, 9 are Not Obvious over the Lewis Reference in view of the Trebitz Reference.

As understood by Applicant, the Lewis reference discloses a mug with a handle and an annular lip that can be integrally formed with the mug body, and a removable decorative character skin to be attached over the mug body. The Lewis reference doe not disclose a clip on its mug assembly as the Examiner agreed.

Amended Claim 6 is not obvious over the Lewis reference over the Trebitz reference because the handguard in the Trebitz cannot not be a clip and further, it is not solely connected to the handle as fully discussed in the previous section. Claim 6 should be further rendered non-obvious on another ground that the Lewis reference fails to teach or suggest employing a clip on

its mug assembly. It is well settled that to modify references, there must be some suggestion to do so, even for simple changes or combinations. See In re Chu, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995) (“Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down”). In re Gordon, 733 F.3d 900, 902, 221 USPQ 1125, 1227 (Fed. Cir. 1984) (“The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.”). To modify a prior art reference to render a patent obvious requires that “the prior art suggested the desirability of the modification.” In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

As understood by Applicant, nothing in the Lewis reference discloses the desirability of employing a clip onto its mug assembly. Also, the Examiner has not cited any technical reasoning or basis for combining references. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” Id at 1783-84. Where the incentive to combine the teachings of the references is not readily apparent, it is the duty of the Examiner to explain why the combination of reference teachings is proper. *Ex parte Skinner*, 2 USPQ 2d. 1788, 1790 (B.P.A.I. 1986). Further, the Examiner represented that the motive for one of ordinary skill in the art to incorporate the ‘clip’ disclosed by the Trebitz reference into the mug disclosed by the Lewis reference would be “to act as a hand guard to protect the hand from direct contact with the container and help keep the handle in position.” Demonstrably, however, this cannot be the proper motivation for combining the Lewis and the Trebitz references because what is needed is the motivation for introducing a clip in a drinking cup to retain an article, not motivation for employing some means to protect a cup-holding hand.

Amended dependent Claim 9 should be also deemed non-obvious over the Lewis reference over the Trebitz reference because its parent Claim 6 is believed to be non-obvious. It is also non-obvious because the Lewis reference fails to teach one of the elements of Claim 9, a cup liner. The Examiner identified the cylindrical mug body **12** in the Lewis reference as the cup liner in Claim 9. However, it cannot serve as the cup liner as defined in Claim 9 because the cup liner must be an entity separate from a container body, which is to be inserted into the container body for the purpose of insulation, helping keep the drink at a constant temperature. (Application at page 8, lines 8-9). The mug body **12** in the Lewis reference is the container body itself, not a separate element to be inserted into the container body for heat insulation.

Further, the mug body **12** fails to meet another structural limitation for the cup liner in Claim 9. The cup liner in Claim 9 is required to be solely connected to the rim. But even assuming *arguendo* the mug body **12** of the Lewis reference were the cup liner, which it is not, the mug body is not only connected to the top annular lip **15** but also to the mug handle **14**. This is clearly against the express limitation of Claim 9. For this reason as well, Claim 9 should be deemed distinguishable from the Lewis reference.

D. Claims 16-23 Are Not Obvious over the Lewis Reference in view of the Trebitz Reference.

Amended independent Claim 16 basically comprises a vessel body and connected with it, the unitary construction of amended independent Claim 6 carrying all its elements and limitations. Therefore, Claim 16 is non-obvious over the Lewis reference in view of the Trebitz reference for exactly the same reason why Claim 6 is deemed non-obvious, as previously discussed in the section C. Claim 16 is further distinguishable from the Lewis reference in another aspect. The

Examiner stated that 'the outer shell 16' in the Lewis reference corresponds to the 'vessel body' of Claim 16. However, Applicant respectfully disagrees with this characterization because what the Examiner has cited for the 'vessel body' of Claim 16 appears to be in fact a 'decorative character skin 16' to be clothed on the mug body 12, as shown in both the specification and FIGS. 1-2 of the Lewis reference. (Col. 4: 10-21). Instead, the 'mug body 12' in the Lewis reference must be identified with the vessel body of Claim 16. The 'decorative character skin 16' in the Lewis reference cannot be the vessel body in Claim 16 because it is not shaped as a container or a vessel to contain drinking fluid and further it is removable from 'mug body 12'. (Col. 4:13-15). For this reason as well, Claim 16 is distinguishable from the Lewis reference. In the respect that the parent Claim 16 is believed to be non-obvious, its dependent Claims 17, 18, and 20 are also believed to be non-obvious.


Amended Claims 19 and 21, depending from Claim 16, further comprise two more elements, the cup liner and the rim. They are also believed to be non-obvious over the Lewis reference in view of the Trebitz reference in the respect that their parent Claim 16 is. Moreover, they are further distinguishable from the Lewis reference on two additional grounds. Firstly, as discussed above, the 'mug body 12' in the Lewis cannot act as the cup liner in Claims 19 and 21 for the same reason it is not the cup liner in Claim 9. Secondly, even assuming *arguendo* the mug body 12 were the cup liner, which it is not, the Lewis reference discloses that it is not solely connected, as required in Claim 19 and 21, to the top annular lip 15, or the rim, but connected to the mug handle 14 as well. Claims 22 and 23 have been amended to merely provide further clarity and consistency with other claims. Being dependent from Claims 19 and 21 respectively, they should be deemed non-obvious as well to the extent that Claims 19 and 21 are. Claims 24-26, which were rejected as being obvious, have been canceled.

III. Conclusion

For all the reasons advanced above, Applicant respectfully submits that the claims, as amended, are in condition for allowance and accordingly requests that such action be taken by the Examiner.

Respectfully Submitted,

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By: 

Woo Soon Choe

Registration No. 56,726

THE SONI LAW FIRM

55 S. Lake Avenue, Suite 720

Pasadena, CA 91101

Phone: (626) 683-7600

Fax: (626) 683-1199

Email: woosoon@sonilaw.com